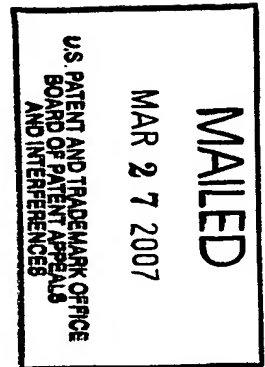


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN MATTHEW SANTOSUOSSO

Application 10/007,713



ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on December 19, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matter requiring attention prior to docketing is identified below:

BACKGROUND

On August 4, 2006, the Office entered an Examiner's Answer including new grounds of rejection under 35 U.S.C. § 101. In response, Appellant filed an Amendment and a Reply under 37 CFR §1.111 on October 3, 2006 requesting that the prosecution of the application be reopened. On November 3, 2006, the Examiner mailed a communication acknowledging receipt of the request to reopen prosecution, withdrawing only the new ground of

rejection under 35 U.S.C. § 101. The Examiner then forwarded the application to the Board of Patent Appeals and Interference for consideration of the appeal.

A reply under 37 CFR § 1.111 requesting that the prosecution of an application be reopened is treated by the Board as a request to withdraw the appeal in accordance with 37 C.F.R. § 41.39(b)(1). In addition, 37 CFR § 41.39(b)(1) states that “[a] request that complies with this paragraph will be entered and the application or the patent under ex parte reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. “

According to 37 CFR § 1.112:

After reply by applicant or patent owner (§ 1.111 or § 1.945) to a non-final action and any comments by an inter partes reexamination requester (§ 1.947), the application or the patent under reexamination will be reconsidered and again examined. The applicant, or in the case of a reexamination proceeding the patent owner and any third party requester, will be notified if claims are rejected, objections or requirements made, or decisions favorable to patentability are made, in the same manner as after the first examination (§ 1.104). Applicant or patent owner may reply to such Office action in the same manner provided in § 1.111 or § 1.945, with or without amendment, unless such Office action indicates that it is made final (§ 1.113) or an appeal (§ 41.31 of this title) has been taken (§ 1.116), or in an inter partes reexamination, that it is an action closing prosecution (§ 1.949) or a right of appeal notice (§ 1.953).

Application No. 09/653,227

The Examiner's communication mailed on October 30, 2006, does not comply with 37 CFR § 1.112.

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner for appropriate action on the following:

- 1) to vacate the Examiner's Communication dated November 3, 2006.
- 2) to "reconsider and again examine" the application consistent with 37 CFR § 1.112 and Office policy; and
- 3) to notify Appellants of the Examiner's reconsideration consistent with 37 CFR § 1.112 and Office policy.

BOARD OF PATENT APPEALS
AND INTERFERENCES



PATRICK J. NOLAN
Deputy Chief Appeals Administrator
(571) 272-9797

Application No. 09/653,227

DMS:kis

CC: IBM CORPORATION
INTELLECTUAL PROPERTY LAW
DEPT. 917, BLDG. 006-1
3605 HIGHWAY 52 NORTH
ROCHESTER, MN 55901-7829